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OFFICE OF PETITIONS

In re Patent No. 6,800,434
Saksena et al.
Issue Date: October 5, 2004
Application No. 09/909,062
Filed: July 19, 2001
Atty Docket No. IN01157K

:
: DECISION ON
: APPLICATION FOR
: PATENT TERM ADJUSTMENT
: and
: DECISION ON REQUEST FOR
: RECONSIDERATION OF
: PATENT TERM ADJUSTMENT
: and
: NOTICE OF INTENT TO ISSUE
: CERTIFICATE OF CORRECTION
:
:

This is in response to both the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 CFR § 1.705" filed August 10, 2004, and the SUPPLEMENTAL APPLICATION FOR PATENT TERM ADJUSTMENT FILED UNDER 37 CFR § 1.705(e)," filed November 2, 2004. Patentees request that the initial determination of patent term adjustment under 35 U.S.C. 154(b) of zero (0) days shown on the PTOL-85 mailed May 19, 2004 be revised to reflect a PTA of sixty (60) days. Patentees further request that the patent term adjustment indicated in the patent be corrected to not include a reduction of fifty-seven (57) days for the filing of the application for patent term adjustment on August 10, 2004.

The application for patent term adjustment under § 1.705(b) filed August 10, 2004 is **GRANTED** to the extent indicated herein. However, no correction of the patent term adjustment of 0 days at the time of the mailing of the Notice of Allowance is required.

The request for reconsideration of patent term adjustment under § 1.705(d) is **GRANTED**.

The patent term adjustment indicated in the patent is to be corrected by issuance of a certificate of correction showing a revised Patent Term Adjustment of fifty (50) days.

on Application for Patent Term Adjustment

On May 19, 2004, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is 0 days. The instant application for patent term adjustment was timely filed¹. Then applicants asserted entitlement to additional periods of adjustment totaling 186 days. First, applicants asserted entitlement to a period of adjustment of 153 days for delay in mailing the notice of allowance to the correct customer. Applicants stated that the original notice mailed December 18, 2003 was mailed to an unrelated third party; and the corrected notice was not mailed until May 19, 2004. Second, applicants asserted entitlement to a period of adjustment of 33 days for Office delay until March 26, 2003 to respond to applicants' response filed October 21, 2002. Given the additional 186 days of adjustment, applicants asserted that at the time of the mailing of the notice of allowance, the application was entitled to 60 days of patent term adjustment².

The application history has been reviewed and it has been determined that the initial patent term adjustment of 0 days is correct. However, an additional period of adjustment should have been entered (but with a net result of 0 days of PTA).

A period of adjustment of 111 days, not 153 days, should have been entered for Office delay in responding to applicants' reply filed September 29, 2003. The Office mailed a notice of allowance under section 151 on December 18, 2003, within four months of the date of filing of applicant's reply, September 29, 2003. However, the Notice was not mailed to the correspondence address of record. Accordingly, a "corrected" notice of allowance was mailed on May 19, 2004. The record supports a conclusion that this re-mailing was due to an error on the part of the Office in mailing the first notice of allowance to applicants. Thus, the re-mailing of the notice of allowance does constitute a delay by the Office in the issuance of the patent within the meaning of 35 U.S.C. 154(b).

The number of days in the period of delay beginning on January 30, 2004, the day after the date that is four months after the date a reply under § 1.111 was filed, to May 19, 2004, the date of mailing of the corrected notice of allowance is 111 days. See § 1.703(a)(2).

However, applicants' contention that the application is entitled to an additional period of adjustment for Office delay in responding to their response to election requirement filed October 21, 2002 is not persuasive. On December 19, 2002, the examiner mailed an Office action, requiring compliance with sequence rules in order to continue prosecution of this application. This action by the Office was taken within four months of the date of filing of applicants' reply. In addition,

¹ The Issue Fee payment was also received on August 10, 2004.

² Applicants agreed with the period of adjustment of 13 days, and the reductions of 95 and 44 days.

this Office action was not issued as part of the pre-examination processing of the application, but was issued by the examiner as a result of an examination conducted pursuant to 35 U.S.C. 131. Compliance had to be obtained before the non-final Office action could be mailed. Entry of a period of adjustment, particularly where it would include a period during which Office action was delayed until applicants filed the papers necessary to place the application in compliance with the sequence rules³, is not warranted.

In view thereof, the correct patent term adjustment at the time of the mailing of the notice of allowance is zero (0) days (111 + 13 days of Office delay) reduced by (44 + 95 days of applicant delay).

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

on Request for Reconsideration of PTA indicated in Patent

On October 5, 2004, the above-identified application matured into U.S. Patent No. 6,800,434, with a patent term adjustment of 0 days printed on the front page. The initial patent term adjustment of zero (0) days (reflecting a period of adjustment of 13 days minus a period of reduction of 139 days) was increased by 65 days for Office delay, but further reduced by 57 days for applicant delay. Patentees dispute the reduction of 57 days associated with a "Miscellaneous Incoming Letter" filed August 10, 2004.

A review of the application history reveals that the only paper filed August 10, 2004 was the application for patent term adjustment. 37 CFR 1.704(e) provides that:

Submission of an application for patent term adjustment under § 1.705(b) (with or without request under § 1.705(c) for reinstatement of reduced patent term adjustment) will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under paragraph (c)(10) of this section.

Accordingly, the patent term adjustment should not have been reduced by 57 days.

In view thereof, it is concluded that the patent should have issued with a revised Patent Term Adjustment of fifty (50) days (189 days of Office delay reduced by 139 days of applicant delay).

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required. The fee is required for consideration under § 1.705(d) and will not be waived.

The application file is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction in

³ It is further noted that applicants obtained a one-month extension of time to comply with sequence rules.

order to rectify this error. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **FIFTY (50)** days.

Telephone inquiries specific to this decision should be directed to Nancy Johnson, Senior Petitions Attorney, at (571) 272-3219.

*Karin Ferriter
for*

Karin Ferriter
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy

Enclosure: Copy of DRAFT Certificate of Correction